The Office Action provisional rejects claims 1-9 and 26-36 under 35 U.S.C. § 101 as being identical to claims 1-9 and 26-36 of co-pending application number 10/230,368. The rejection is incorrect as a matter of law. Under MPEP 804 *et seq.*, a double-patenting rejection cannot be maintained against claims which were subject to a species requirement in the parent application. As such, the rejection is improper as a matter of law and must be withdrawn.

The history of species rejections against the present family of applications is well documented. Applicant provided a summary of the same in the Preliminary Amendment for this case filed on February 13, 2004. As stated therein:

> Claims 1-10 and 29-36 of the present application are identical to the corresponding claims of co-pending U.S. Patent Application Serial No. 10/230,368 ("the '368 parent application"), which is the parent of the instant application. In the '368 parent application, the Examiner issued a species based restriction requirement dated April 22, 2003, which stated that (1) the claims would be limited to an elected species if no generic claim was allowed, and (2) no claim appeared to be generic. Applicant subsequently elected claims 1-10 and 19-36 as directed to the species of radial deployment of structures made from different materials.
>
> Although the Examiner allowed claims 1-10 and 29-36 on first action, none of these claims were expressly identified by the Examiner as generic. Accordingly, to the extent that the noted claims from the parent application are limited to the elected species, then Applicant herein resubmits these claims for consideration with respect to the previously unelected species. This includes structures with lateral cell deployment and/or use of the same materials.

The Office Action does not acknowledge the history of species restrictions and how they preclude any double-patenting rejection against the same subject matter.

As stated in MPEP 804.01, once the requirement for restriction was made in the parent application, a subsequent double-patenting rejection was prohibited against the restricted subject

matter in the resulting divisional application. MPEP 804.01 expressly applies the prohibition against the combination/subcombination-based species restrictions of the type that the Examiner applied against the parent claims. MPEP 804.01 further expressly states that when the restriction requirement was made subject to the non-allowance of generic or other linking claims, the prohibition against double patenting is only lifted if such generic claims were ultimately allowed. As discussed above, the Examiner did not consider any of the pending claims generic and never withdrew the species requirement.

The instant double-patenting rejection is thus exactly what MPEP 804.01 was designed to prevent. In the parent application, the Examiner expressly stated that claims 1-10 and 29-36 would be limited to the elected species if no claim was held generic. Per the Examiner's findings, to the extent that the scope of claims 1-10 and 29-36 covered non-elected species, those non-elected species were patentably distinct from the elected species. (A point which Applicant vigorously traversed but on which the Examiner was not persuaded.) Thus, while pending claims 1-10 and 29-36 may have the same words as those from the parent application, the two claim sets are directed to species which the Examiner has already determined to be patentably distinct from one another, and for which MPEP 804.01 precludes subsequent rejection based on double patenting.

Any other outcome would produce absurd results. Having restricted the non-elected species out of the parent, a double-patenting rejection would prevent consideration of the non-elected species in the divisional application. As a practical matter, the unelected species from the parent application could never be examined.

Accordingly, the pending rejection is improper as a matter of law and must be withdrawn. As there are no other pending rejections, allowance of the application is therefore respectfully requested.

Should there by any questions, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,

Dated: January 25, 2005

for Scott D. Watkins
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